



hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C., 20231, on:

Date: 15 August 1994

By: [Signature] #3

Docket No. 8600-0146

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Christopher H. Contag, et al.

Serial No. 08/270,631

Filed: July 1, 1994

For: Non-Invasive Localization of  
a Light-Emitting Conjugate  
in a Mammal

Examiner: Unknown

Art Unit: Unknown

Attention: Application Branch

**RECEIVED**

**SEP 12 1994**

**Response to Notice to File Missing Parts of Application**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

In response to the Office action mailed August 1, 1994 (copy attached), applicant hereby submits a Declaration of inventorship, an Assignment for recordation, a Power of Attorney and Exclusion of Inventor(s) of the assignee, and a Verified Statement Claiming Small Entity Status of the assignee of the above-captioned application. Also enclosed is counsel's check for \$534.00 in payment of the basic filing fee (\$355.00 + 74.00 in additional claim fees), the surcharge for late filing of declaration or oath (\$65.00), plus the fee (\$40.00) for recording the enclosed Assignment.

Please charge any underpayment (or credit any overpayment) of fees to Deposit Account No. 04-0531. A duplicate copy of this Response is attached.

Respectfully submitted,

[Signature]  
Charles K. Sholtz  
Registration No. P38,615

Date: 15 August 1994

Correspondence Address:  
Dehlinger & Associates  
P.O. Box 60850  
Palo Alto, California 94306  
(415) 324-0880

**Patent Application Declaration and Power of Attorney**

I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated next to my name in PART A on page 2 hereof.

I believe I am the original, first, and sole inventor (if only one name is listed) or an original, first and joint inventor (if plural names are listed) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**Non-Invasive Localization of a Light-Emitting Conjugate in a Mammal**

the specification of which:

- ☐ is attached hereto.
- ☒ was filed July 1, 1994 as Attorney Docket No. 8600-0146.
- ☒ was filed July 1, 1994 as Application Serial No. 08/270,631.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed in PART B on page 2 hereof and have also identified in PART B on page 2 hereof any foreign application for patent or inventor's certificate having a filing date before that of the application of which priority is claimed.

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed in PART C on page 2 hereof and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following as my attorney or agent with full power of substitution to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith:

Peter J. Dehlinger	Reg. No. <u>28,006</u>
Gary R. Fabian	Reg. No. <u>33,875</u>
Vincent M. Powers	Reg. No. <u>36,246</u>
Charles K. Sholtz	Reg. No. <u>P38,615</u>
Susan T. Evans	Reg. No. <u>P38,443</u>
Judy M. Mohr	Reg. No. <u>P38,563</u>

whose mailing address for this application is: Dehlinger & Associates  
P.O. Box 60850  
Palo Alto, CA 94306

See Page 2 attached, signed, and made a part hereof.

*over*

**Patent Application Declaration and Power of Attorney**

**PART A: Inventor Information and Signature**

Full name of SOLE or FIRST inventor Christopher H. Contag 1-00  
Citizenship U.S.A. Post Office Address 2017 California Street #5B  
Mountain View, California 94040  
Residence (if different) (same) CA  
Inventor's Signature: *Christopher H. Contag* Date: 8/10/94

Full name of SECOND joint inventor, if any Pamela R. Contag 2-00  
Citizenship U.S.A. Post Office Address 2017 California Street #5B  
Mountain View, California 94040  
Residence (if different) (same) CA  
Second Inventor's Signature: *Pamela R. Contag* Date: 8/10/94

Full name of THIRD joint inventor, if any David A. Benaron 3-00  
Citizenship U.S.A. Post Office Address 454 Birch Street  
Redwood City, California 94062  
Residence (if different) (same) CA  
Third Inventor's Signature: *David A. Benaron* Date: 8/11/94

\*\*\*\*\*

**PART B: Prior Foreign Application(s)**

Serial No.	Country	Day/Month/Year Filed	Priority Claimed	
			<input type="checkbox"/> Yes	<input type="checkbox"/> No
			<input type="checkbox"/> Yes	<input type="checkbox"/> No

**PART C: Claim for Benefit of Filing Date of Earlier U.S. Application(s)**

Serial No.	Filing Date	Status:
		<input type="checkbox"/> Patented <input type="checkbox"/> Pending <input type="checkbox"/> Abandoned
		<input type="checkbox"/> Patented <input type="checkbox"/> Pending <input type="checkbox"/> Abandoned

See Page 1 to which this is attached and from which this Page 2 continues.

*over*

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an Envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231, on:



Date: 15 August 1994

By: Charles K. Sholtz

Document No. 8600-0146

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re application of

Christopher H. Contag, et al.

Examiner: Unknown

Serial No. 08/270,631

Art Unit: Unknown

Filed: July 1, 1994

For: **NON-INVASIVE LOCALIZATION OF  
A LIGHT-EMITTING CONJUGATE  
IN A MAMMAL**

**Power of Attorney by Assignee and Exclusion  
of Inventor(s) Under Rule 32**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

The undersigned assignee of the entire interest in the above-referenced subject application by virtue of assignment recorded concurrently hereby appoints PETER J. DEHLINGER, Reg. No. 28,006; GARY R. FABIAN, Reg. No. 33,875; CAROL A. STRATFORD, Reg. No. 34,444; VINCENT M. POWERS, Reg. No. 36,246; CHARLES K. SHOLTZ, Reg. No. P38,615; JUDY M. MOHR, Reg. No. P38,563; and SUSAN T. EVANS, Reg. No. P38,443 as its attorneys/agents to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith, said appointment to be the exclusion of the inventor(s) and their attorney(s) in accordance with the provisions of Rule 32 of the Patent Office Rules of Practice.

Assignee hereby declares that, to the best of its knowledge and belief, title is in the assignee herein, and affirms review of the evidentiary document (of record, above identified) relied upon to establish such ownership.

Please direct all telephone calls to (415) 324-0880 and all correspondence relative to said application to the following address:

Dehlinger & Associates  
P.O. Box 60850  
Palo Alto, California 94306

I have reviewed the Assignment document concurrently submitted and believe that the above-referenced application has been assigned to assignee herein and that assignee therefore has the right to make this Power of Attorney and Exclusion of Inventor(s); I am duly authorized to sign this instrument on behalf of assignee corporation.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

ASSIGNEE: THE BOARD OF TRUSTEES OF THE LELAND STANFORD JR.  
UNIVERSITY

Signature: \_\_\_\_\_

Typed Name: Katharine Ku

Title: Director, Technology Licensing

Address: Stanford University  
Office of Technology Licensing  
900 Welch Road, Suite 350  
Palo Alto, CA 94304

44-38861-1000

Attorney Docket No.: 8600-0146

Applicant: Christopher H. Contag, et al.

Serial No.: 08/270,631

Filing Date: July 1, 1994

For: **NON-INVASIVE LOCALIZATION OF A LIGHT-  
EMITTING CONJUGATE IN A MAMMAL**

**Verified Statement (Declaration) Claiming Small Entity Status  
(37 CFR §1.9(f) and §1.27(c) - Nonprofit Organization**

I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below:

Name of Organization: The Board of Trustees of the Leland Stanford Junior University

Address of Organization: Office of Technology Licensing, 900 Welch Road, Suite 350, Palo Alto, California, 94304

- ☒ University or other institution of higher education.
- ☐ Tax exempt under Internal Revenue Service Code (26 USC §501(a) and §501(c)(3)).
- ☐ Nonprofit scientific or education under statute of state of the United States of America.
- ☐ Name of State: \_\_\_\_\_
- ☐ Citation of Statute: \_\_\_\_\_
- ☐ Would qualify as tax-exempt under Internal Revenue Service Code (26 USC §501(a) and §501(c)(3)) if located in The United States of America.
- ☐ Would qualify as nonprofit scientific or educational under statute of state of The United States of America if located in The United States of America.
- ☐ Name of State: \_\_\_\_\_
- ☐ Citation of Statute: \_\_\_\_\_

I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 37 CFR 1.9 (e), for purposes of paying reduced fees under section 41(a) and (b) of Title 35, United States Code, with regard to the invention entitled Non-Invasive Localization of a Light-Emitting Conjugate in a Mammal by inventor(s) Christopher H. Contag, Pamela R. Contag, and David A. Benaron described in:

- ☐ the specification filed herewith.
- ☒ Application Serial No. 08/270,631, filed July 7, 1994.
- ☐ Patent No. \_\_\_\_\_, issued \_\_\_\_\_.

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights to the invention is listed below\* and no rights to the invention are held by any person, other than the inventor, who could not qualify as a small business concern under 37 CFR §1.9 (d) or by any concern which would not qualify as an independent inventor under 37 CFR §1.9 (c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR §1.9 (d) or a nonprofit organization under 37 CFR §1.9 (e).

\* NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR §1.27).

over

Name: \_\_\_\_\_

Address: \_\_\_\_\_

☐ individual ☐ small business concern ☐ nonprofit organization

Name: \_\_\_\_\_

Address: \_\_\_\_\_

☐ individual ☐ small business concern ☐ nonprofit organization

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate (37 CFR §1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such wilful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Name of person signing: Mary K. Albertson

Title of person signing: Associate

Address of person signing: Office of Technology Licensing, 900 Welch, Palo Alto

Signature: Mary K. Albertson Date: August 12, 1994

APPLICATION NUMBER	08/270.631	07/01/94	CONTAG	86000146
FILING DATE	07/01/94	08/270.631	07/01/94	08/270.631
FIRST NAMED APPLICANT	DEHLINGER & ASSOCIATES P.O. BOX 60850 PALO ALTO, CA 94306			
ATTY. DOCKET NO./TITLE	86000146			

## NOTICE TO FILE MISSING PARTS OF APPLICATION FILING DATE GRANTED

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted **ALONG WITH THE PAYMENT OF A SURCHARGE** for items 1 and 3-6 only of \$130. For small entities or for large entities or for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a ☒ large entity, ☐ small entity (verified statement filed), is \$ 988.

Applicant is given **ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE OF THIS APPLICATION, WHICHEVER IS LATER**, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

1. ☒ The statutory basic filing fee is: ☒ missing ☐ insufficient. Applicant as a ☒ large entity ☐ small entity, must submit \$ 210 to complete the basic filing fee.

2. ☒ Additional claim fees of \$ 148 as a ☒ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

3. ☐ The oath or declaration: ☐ is missing. ☐ does not cover items omitted at time of execution.

An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date is required.

4. ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

5. ☒ The signature to the oath or declaration is: ☒ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

6. ☐ The signature of the following joint inventor(s) is missing from the oath or declaration:

An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

7. ☐ The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of \$            under 37 CFR 1.17(k), unless this fee has already been paid.

8. ☐ A \$            processing fee is required for returned checks. (37 CFR 1.21(m)).

9. ☐ Your filing receipt was mailed in error because check was returned without payment.

10. ☐ The application does not comply with the Sequence Rules. See attached Notice to Comply with

070 MY 098640633 082270631 1 201 355.00 CK  
070 MY 09/02/94 082270631 1 203 74.00 CK  
070 MY 02/27/94 082270631 1 205 45.00 CK  
Division, Special Processing and Correspondence Branch (703) 508-1202  
Application Processing

A copy of this notice **MUST** be returned with the response.

COPY TO BE RETURNED WITH RESPONSE

FORM PTO-1533 (REV. 6-93)